



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,902	10/19/2001	John C. Jones	1056-P-1	8318

7590

07/25/2003

Tod R. Nissle, Esq.  
TOD R. NISSLE, P.C.  
P.O. Box 55630  
Phoenix, AZ 85078

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 07/25/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/032,902

Applicant(s)

JONES, JOHN C.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1, drawn to a cement plaster composition, classified in class 106, subclass 713.
  - II. Claim 2, drawn to a method for coating the surface of a swimming pool, classified in class 106, subclass 713.
  - III. Claim 3, drawn to a method for coating a surface of a swimming pool, classified in class 427, subclass 230.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions recite mutually exclusive compositions and, consequently, are not disclosed as useable together and have different functions.
3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions recite mutually exclusive compositions and, consequently, are not disclosed as useable together and have different functions.

4. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions recite mutually exclusive compositions and, consequently, are not disclosed as useable together and have different functions.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Mr. Tod R. Nissle (reg. no. 29,241) on 11 July 2003 a provisional election was made *without* traverse to prosecute the invention of Group III, claim 3. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1 and 2 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Drawings***

8. The drawings are objected to by the Draftsperson as set-forth in the attached form PTO-948. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

9. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the *claims* are directed.

The following title is suggested: METHOD OF FORMING A SMOOTH, POLISHED COATING ON THE SURFACE OF A SWIMMING POOL.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Torrance (US 2002/063352 A1) in view of Yon (US 5,650,004 A) and Torrance et al. (US 5,620,364 A).**

12. Torrance '352 teaches a method in which an aggregate-containing cement slurry is applied to the surface of a swimming pool, allowed to dry, and polished by grinding to reveal the aggregate and yield a smooth, glossy surface [abstract; paras. 2, 5, 7, 10, 12, 16 – 19, 23, 24, 33, and 34; and claims].

13. Torrance '352 teaches that the aggregate-containing cement slurry may include or be comprised of other materials commonly used in the industry [para. 24], but does not specifically teach the composition claimed by applicant. Further, Torrance '352 teaches grinding by means of a water-driven rotary tool [para. 33], but does not specifically teach the rotating, water-cooled polishing head embedded with hard particles claimed by applicant.

14. Yon teaches a cement plaster composition for plastering swimming pool surfaces comprising: from about 20% to about 50% by weight of a Portland cement; from about 50% to about 80% of aggregate; and the balance water [c. 2, ll. 20 – 45 and c. 4, ll. 37 – 47]. The plaster coatings possess excellent long-term stability and performance in an underwater environment [c. 2, ll. 47 – 57; c. 4, l. 64 – c. 5, l. 12].

15. In view of the teaching of Torrance '352, that compositions commonly used in the art may be applied as the aggregate-containing cement slurry, one of ordinary skill in the art would

have looked to the prior art for suitable compositions. Yon teaches coating a swimming pool surface with applicant's claimed composition, said composition possessing excellent long-term stability and performance. Consequently, it would have been obvious to one of ordinary skill in the art to modify the method of Torrance '352 so as to utilize, as the cement coating composition, the composition of Yon. One of ordinary skill in the art would have been motivated to do so by the teaching of Torrance '352 that any commonly-used composition may be utilized, as well as the advantages of utilizing such a composition taught by Yon.

16. Torrance '364 teaches a water-driven rotary grinder for wet-grinding or wet-polishing of underwater or dry stone or cement surfaces, including those of a swimming pool [c. 1, ll. 1 – 52]. The water-driven tool comprises a rotating head to which a suitable grinding or polishing head may be attached [c. 1, ll. 48 – 51 and l. 66 – c. 2, l. 2; c. 3, ll. 1 – 6 and ll. 37 – 54; and c. 4, l. 19 – c. 6, l. 43]. The grinder of Torrance '364 does not require electricity and presents no danger of electric shock when utilized underwater or near water.

17. Since Torrance '352 teaches utilizing a water-driven rotary tool (in particular the very tool of Torrance '364), it would have been obvious to one of ordinary skill in the art to modify the method of Torrance '352 to utilize, as the grinder, the tool of Torrance '364. One of ordinary skill in the art would have been motivated to do so by the direct suggestion of Torrance '352 and the advantages attendant a water-powered tool.

18. The examiner notes that, while Torrance '364 teaches that suitable grinding/polishing pads may be utilized, the reference does not explicitly teach such a pad embedded with hard particles. It is the examiner's position that it is well-known in the art that such polishing heads comprise paper or polymer backings, coated with a resin embedded with abrasive particles.

Consequently, it would have been obvious to one of ordinary skill in the art to have utilized such a polishing pad, and further obvious to select a pad with abrasive particles with a suitable hardness necessary to accomplish the polishing/grinding operation at-hand.

19. Further, the examiner notes that Torrance '364 does not explicitly state that the tool is water-cooled. It is the examiner's position that, when the tool is utilized underwater, according to one embodiment of Torrance '364, the tool is inherently water-cooled. When the tool is not utilized underwater, water is ejected around the rotating head [c. 3, ll. 1 – 6 and ll. 36 – 53]. Absent clear and convincing showings or evidence to the contrary, it is the examiner's position that the head is also, in this instance, water-cooled.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Murray (US 4,398,960 A) and Johnson et al. (US 4,428,775 A) represent the state of the art in aggregate-containing cement slurry compositions. Torrance-Castanza et al. (US 6,203,415 B1) teaches another water-driven rotary grinding/polishing tool similar to that of Torrance '364.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (703) 308-7956. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.




Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

William P. Fletcher III  
Examiner  
Art Unit 1762

**WPS**

July 21, 2003



SHRIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700